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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/468,777 12/21/99 HASEBE

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EXAMINER

HM12/0620

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ART UNIT

PAPER NUMBER

1619

DATE MAILED:

06/20/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/468,777

Applicant(s)

HASEBE ET AL.

Examiner

Lauren Q Wells

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Arguments***

As a result of Applicant's amendment, amending claims 1-10 and adding claims 11-19, filed May 14, 2001 (Paper No. 6), Examiner hereby withdraws 102(b) and 103(a) rejection. Furthermore, Applicant's arguments with respect to claims 11-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pillai et al. (5,476,661) in view of Vanlerberghe et al. (5,985,255).

Pillai et al. teach cosmetic compositions for topical application to skin, hair, and nails. Amphipathic lipids are disclosed as comprising 0.0001-50% of the composition and surfactants are disclosed as comprising 0.5-30% of the compositions. Surfactants disclosed include alkoxylated compounds based upon fatty alcohols, fatty acids and sorbitan and alkyl

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polyglycosides. See Col. 4, line 24-Col. 11, line 61; Col. 13, line 45-line 67; Col. 22, line 30-Col. 25, line 3. The reference lacks teaching average particle size.

Vanlerberghe et al. teach cosmetic compositions for use as hair care products. Particles having an average diameter between 0.1-200  $\mu\text{m}$  are disclosed as known in the art. See Col. 1, line 8-Col. 2, line 11.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of Pillai et al. using the teachings in Vanlerberghe et al. and obtain a composition comprising particles having an average diameter between 0.1 and 200um because a) Pillai et al. and Vanlerberghe et al., in reference to FR 2,369,340, both teach cosmetic compositions for topical application to the hair; b) Pillai et al. and Vanlerberghe et al., in reference to FR 2,369,340 both teach lipids as active components of the composition.

#### ***Additional Response to Arguments***

Applicant argues that “the reference (Pillai et al.) does not describe the lipid components as a dispersion in surfactant and aqueous medium and average particle size of 0.5 to 150um”.

This argument is not persuasive. In response to applicant's arguments, the recitation “dispersion” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, the selection of particle size is

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not a patentable modification in the absence of unobvious results. *In re Rose*, 105 U.S.P.Q. 237 (C.C.P.A. 1955).

Applicant argues, "why would one of skill in the art of hair, skin and nail care be motivated to formulate the lipid component of the skin composition of Pillai et al. to have an average particle size of from 0.5 to 150 um? The lipid component of Pillai et al. is not a perfume vehicle." Examiner respectfully points out that (Col. 1, lines 11-31) Vanlerberghe et al. disclose a French patent that teaches a solid, liquid, or pasty perfumed composition that is useful for conditioning of the hair. Thus, one of ordinary skill in the art at the time the invention was made would have been motivated to modify the composition of Pillai et al. using the teachings in Vanlerberghe et al. and obtain a composition comprising particles having an average diameter between 0.1 and 200um because a) Pillai et al. and Vanlerberghe et al., in reference to FR 2,369,340, both teach cosmetic compositions for topical application to the hair; b) Pillai et al. and Vanlerberghe et al., in reference to FR 2,369,340 both teach lipids as active components of the composition.

In response to Applicant's argument that "Vanlerberghe et al. is directed to... in which the particles have a size of less than 0.5 um", Examiner respectfully notes that Vanlerberghe et al. is cited in the rejection for the information contained in Col. 1, line 8-Col. 2, line 11, its description of French Patent No. 2,369,340 (see present Office Action and Office Action mailed February 12, 2001).

*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

  
**SAMUEL L. JONES**  
**PRIMARY EXAMINER**

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lqw  
June 8, 2001